REMARKS

In the Office Action dated November 16, 2005, claims 14-26 have been examined, and claims 1-13 and 27-39 have been withdrawn from consideration by the examiner.

The examiner has rejected claims 14-26, as further discussed below. Reconsideration of the present application as amended and in view of the additional discussion below is respectfully requested.

THE REJECTIONS UNDER 35 U.S.C. §102

Claims 14-26 were rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,841,854 to Schumacher et al. It is well settled law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference in as complete detail as is contained in the claim. Moreover, it is not sufficient that the prior art reference disclose all of the elements in isolation. Rather, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinefabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984, emphasis added). In traversal, the Applicants submit that Schumacher does not disclose the invention set forth in the claims.

Schumacher discloses a personal communication service 60 or 90 [Schumacher col. 9 lines 30-34] and describes the system/service as operable to receive a call for a desired party from a calling party [Schumacher col. 9 lines 57-61]. The system collects information about the called party and the calling party, and if the called party has registered a mobile device with the system, then the call will be forwarded to that device using the rules stored on the system and "the device will begin ringing" [Schumacher col. 10 lines 4-10].

The system is also described as being operable to implement group functionality within a calling destination. Upon receipt of an incoming call, the system is described to select a user of the system who is available and meets some criteria [Schumacher col. 10 lines 20-28]. Once an agent is selected, "that agent can be notified or alerted that a call is waiting to be serviced" [Schumacher col. 10 lines 30-31]. By alerting the agent of a call, the agent is available to accept the call by going to any convenient telephone (cellular or land-line), PCS handset, wireless device, etc, and calling into the system to be cross-connected to the call [Schumacher col. 10 line 66– col. 11 line 10].

Schumacher describes several methods for notification including a wireless message data network, modem, or packet radio network operable to deliver a message to a wireless terminal, personal digital assistant, a portable personal computer with a wireless receiver, or a personal information manager [Schumacher col. 10 lines 38-64].

In contrast, the invention recited in claim 14 is directed to a system having a server capable of utilizing a data channel to communicate *availability information* to the user subsystems and capable of *responding to commands* from said subsystems sent over said data channel. The Schumacher system describes maintaining availability information, but merely for the purpose of applying "rules" to determine the proper user to handle the call. Furthermore, the notifications cited as sent over a "data channel" alert the user only to the presence of a call and do not contain *availability information* as required by claim 14.

Additionally, claim 14 requires that the server be operable to *respond to command signals carried from the first subsystem to said server by said data channel*. Schumacher describes allowing a user to "choose to answer the call, place the call in voicemail, or re-route the call to another number. The choice is entered using voice processing means such as DTMF

key presses, or voice recognition." [Schumacher col. 12 lines 55-60]. The Schumacher system does not describe PCS server (60 or 90) as being operable to respond to such command signals sent over any of the *data channels* as claimed.

The invention recited in claim 14 is a system having a server capable of utilizing a data channel to communicate availability information to the user subsystems and capable of responding to commands from said subsystems sent over said data channel. For example, a user may be able to request that the server send a call to voicemail, re-route the call to another number, or interact with company information including an address book stored on a central server from a remote location. The user may also send a data message to the server which dynamically changes the user's forwarding number. The system of claim 14 would transmit this command over the data channel, while the system disclosed in Schumacher only enables the user to perform such functions using DTMF tones or voice commands. These new features provide increased mobility and functionality to the users of mobile communications devices and allow them to access a central repository of information that is always up to date from remote location. Accordingly, withdrawal of the rejection of claim 14 in view of Schumacher is respectfully requested.

Dependent claims 15-26 were also rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,841,854 to Schumacher et al. Since claims 15-26 depend from claim 14, claims 15-26 are believed to be in condition for allowance for at least the reasons that claim 14 is allowable stated herein. Furthermore, the applicant submits the arguments below regarding claims 15-26.

With regards to claim 15, there is no inherent disclosure to "update the availability information at predetermined intervals in order to detect a change in availability." For an

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element to be inherently disclosed, it must "necessarily be present in the thing described in the reference." *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Indeed, inherency "may not be established by probabilities or possibilities . . .The mere fact that a certain thing may result from a given set of circumstances is not sufficient." 49 USPQ2d at 1951. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 464 (USPTO Bd. of Pat. App. and Interferences 1990) (emphasis in the original). However, "the fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention." *Toro Co. v. Deere & Co.*, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004). Even assuming for arguments sake that the server in Schumacher could perform the updates in the manner claimed, such updates are still not a necessary consequence of the Schumacher disclosure. For instance, it is conceivable that the updates would be communicated only when the user desired to place a call. Thus, the features recited in claim 15 are not necessarily present in the system, and consequently, would not be inherent in Schumacher.

With regards to claim 16, Examiner Gary has cited [col. 8: lines 8-14] of Schumacher. The cited section describes the server and the real-time information that it tracks for each user, including the user's status as either busy or not responding. However, the cited section also states that the status is "for use as one of the intelligent call delivery criteria." The cited section does not describe the server being *configured to provide the requested update in response to said request* as claimed. In fact, the cited section describes the information as being used only by the server to assist in call routing.

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With regards to claim 17, Examiner Gary has cited [col. 13: lines 25-28] of Schumacher. The cited section describes a data transmission "to provide screening information." The screening information is described as relevant to an incoming call from a third party and not to contain availability information when the status of a *second user* in the *plurality of users* changes.

With regards to claim 18, Examiner Gary has cited [col. 8: lines 8-14] of Schumacher. The cited section describes the server and the real-time information that it tracks for each user, including the user's status as either busy or not responding. Schumacher does not describe that the current status of a user is updated in response to a *request* from a different user.

With regards to claim 19, Examiner Gary has cited [col. 11: lines 55-61] of Schumacher. The cited section describes the process of selecting an agent using the rules and sending either the screening information or the actual call to the selected agent. The cited section does not describe *establishing a voice connection* when the availability information changes to *a predetermined state*. This feature allows a user to "camp" on a selected user so that as soon as the selected user returns to an available status the user will immediately be connected.

With regards to claim 20, Examiner Gary has cited [Fig. 1] of Schumacher. The cited section shows a general overview of the system including several wireless handsets 110, however, the cited section does not show a user interface or describe the capability of generating a request with a *single action*.

With regards to claim 21, there is no inherent disclosure to utilize a log-in procedure. Schumacher describes utilizing DTMF tones to enter selections, but does not describe any security measures to ensure system integrity and limit user access.

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With regards to claim 22 and 23, Examiner Gary has cited [col. 6: lines 33-56] of Schumacher. The cited section describes group membership. However, Schumacher describes group membership solely for the purpose of allowing a caller to "specif[y] the group to contact and reach[] a member of that group." The Schumacher system does not describe limiting the availability information that is accessible to each user in the manner claimed based upon their group membership.

With regards to claim 24, Examiner Gary has cited [col. 10: lines 47-54] of Schumacher. The cited section shows a personal digital assistant, but does not inherently describe using the personal digital assistant to perform the log-in function. For instance, it is conceivable that the log-in procedure would take place using DTMF key presses to verify a user's identity. Thus, the features recited in claim 24 are not necessarily present in the system, and consequently, would not be inherent in Schumacher.

Independent claim 14 was also rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,446,127 to Schuster et al. It is respectfully submitted that Schuster also fails to disclose the limitations recited in claim 14 and thus the rejection must be withdrawn.

In the cited sections, Schuster describes a system 200 for providing user mobility services [Schuster col. 4 lines 23-25]. The system includes a data network 206 which provides a plurality of data communication channels [Schuster col. 4 lines 25-27]. Also included in the system is a plurality of network telephones (e.g. 212, 214, and 216) which are operable to communicate a voice signal as voice-over-data packets through one of the data communication channels. [Schuster col. 4 lines 27-32]. Using the system, a user is able to associate with any of the network telephones using a personal information device 210, such as a personal digital assistant (PDA) [Schuster col. 4 lines 32-34]. In order to enable a user to receive calls at the associated

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network telephone, the network telephone "transmits a registration request to a registration server [202] to register the user with the data network telephone" [Schuster col. 4 lines 35-37].

In contrast, the invention described by claim 14 is a system having a server storing availability information and capable of utilizing a data channel to communicate the stored availability information to a user subsystem and capable of responding to commands from that subsystem which are sent over the data channel. More specifically, claim 14 requires a private communication server configured to *communicate at least a portion of the availability information through said data channel to at least a first subsystem*. Schumacher fails to disclose this limitation as required by claim 14. The system in Schumacher only describes a "registration request" sent from the network telephone to the registration server in order to create an entry upon the registration server associating the user with the specific network telephone. The server is then able, using the entry created, to determine which network telephone to direct an incoming call to in order for the user to properly receive it.

Schumacher also describes a collection of "user attributes" which may include a user identity, schedule information, and information about contacts [Schumacher col. 7 lines 14-17]. These "user attributes" are described as being stored on the personal information device 210 and either programmed into the device by the user or a programming device [Schumacher col. 7 lines 17-29]. The "user attributes" or information about contacts is never described as being transmitted by the server 202 to either the personal information device 210 or the network telephone 208. Accordingly, withdrawal of the rejection of claim 14 in view of Schuster is respectfully requested.

In conclusion, reconsideration and allowance of this application is requested in view of the amendments and remarks made herein. Specifically, claims 14-26 are now in condition for
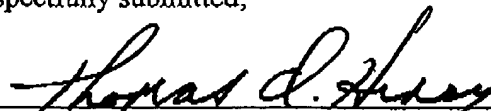
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allowance. If there are any outstanding issues, the Examiner is invited to contact the

undersigned attorney by telephone for their resolution.

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